UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/390,363	09/07/1999	JON N. LEONARD	BEU/LEONARD	6725

7590	10/19/2005

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EXAMINER
DADA, BEEMNET W

ART UNIT	PAPER NUMBER
2135	

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	**Applicant(s)**
Office Action Summary	09/390,363	LEONARD ET AL.
	Examiner	**Art Unit**
	Beemnet W. Dada	2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>23 August 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-50* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☒ Claim(s) 17,34-50 is/are allowed.

6) ☒ Claim(s) *18,26-29,32 and 33* is/are rejected.

7) ☒ Claim(s) *19-26,30 and 31* is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

       1. ☐ Certified copies of the priority documents have been received.

       2. ☐ Certified copies of the priority documents have been received in Application No. _____.

       3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

U.S. Patent and Trademark Office

PTOL-326 (Rev. 7-05)   Office Action Summary   Part of Paper No./Mail Date 10112005

DETAILED ACTION

1.   This office action is in reply to a Pre-Appeal Brief Request filed on August 23, 2005.

Claims 1-50 are pending.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.   Claims 18 and 32-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie

et al. US Patent 6,324,569 B1 (Ogilvie).

4.   As per claim 18, Ogilvie teaches a method of controlling an electronic mail message

transmitted over a network, comprising the steps of:

before transmission of the electronic mail message over the network, attaching to the

message a date, time, or event, the occurrence of which will cause said electronic mail

message and all designated incarnations thereof to expire (i.e., attaching a removal code for

deleting electronic mail after a certain period of time, column 5, lines 59 – column 6, lines 25);

and

encrypting said electronic mail message so that it can only be viewed by using a viewer

applet capable of decrypting the message and installed on a recipient computer, said viewer

applet preventing decryption of said message unless controls set by sender of the electronic

mail message are implemented, said viewer applet thereby preventing viewing of said message

after the occurrence of said time, date or event (i.e., removing messages after a certain period

of time at the recipient viewer applet thereby preventing viewing and decrypting of messages,

column 5, lines 10-15 and column 7, lines 27-39, column 16, lines 7-21) .

5.   As per claims 32 and 33, Ogilvie further teaches attaching flags indicating processing

and handling limitations to said electronic mail message before transmission over said network

and causing said viewer applet to implement said processing and handling limitations [column 5,

lines 5-25].

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 26-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogilvie et al.

US Patent 6,324,569 B1 in view of Anderson US Patent 6,442,600 B1.

8.   As per claims 26-28, Ogilvie teaches the method as applied to claim 18 above. Ogilvie is

silent on a central server encrypting the message before transmitting it to the recipient.

However, within the same field of endeavor, Anderson teaches an email handling system (see

abstract) including an electronic message (i.e. E-mail) is encrypted in the central mail server

(i.e. Message Distribution Server) with the recipient's public key before transmission to said

recipient computer [see column 10 lines 5-14 and figure 6 steps 625,630,635,640]. Both Ogilvie and Anderson teach an email handling systems. It would have been obvious to one having ordinary skill in the art at the time of applicant's invention to employ the teachings of Anderson within the system of Ogilvie in order to allow a centralized management of email distribution and security implementation.

9.   As per claim 29, Ogilvie further teaches the method further comprising causing said viewer applet to store said electronic mail message in encrypted form on said computer and upon the occurrence of said time, date or event erase said electronic mail message [column 5, lines 10-15 and column 7, lines 27-39, column 16, lines 7-21].

Allowable Subject Matter

10.   Claims 1-17 and 34-50 are allowed.

11.   Claims 19-25 and 30-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

12.   Applicant's arguments with respect to claims 18 have been considered but are moot in view of the new ground(s) of rejection under 35 USC 102(e) in view of Ogilvie US Patent 6,324,569 (See rejection of claim 18 above).
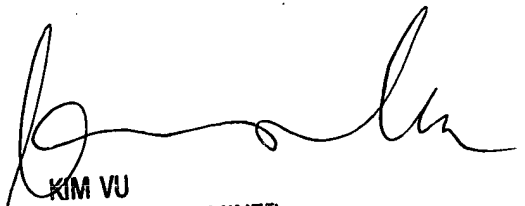
Conclusion

13.   Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Beemnet W. Dada whose telephone number is (571) 272-3847. The

examiner can normally be reached on Monday - Friday (9:00 am - 5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private

PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Beemnet Dada

October 11, 2005

KIM VU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100